

REMARKS/ARGUMENTS

Claims 1-28 are active in this application.

The present invention relates to a composite cut-resistant yarn, that in particular contains no high-performance yarns, but retains high cut resistance, and a fabric formed from such composite yarn. Further, the composite yarn comprises a core with at least one strand of fiberglass and at least one strand of wire which can be arranged in parallel or twisted with one another. The one or more wrap layers of the present invention are made of non-high performance fibers.

The Examiner has rejected the claims under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement, on the basis that the previous amendment to add the proviso that "the composite cut-resistant yarn contains no acrylic fiber" is considered new matter. The Examiner has stated that because the present application did not teach such an exclusion of acrylic fiber and teaches acrylic fiber as one suitable fiber for use in the invention, the change from inclusion to exclusion is new matter. The Examiner has misapplied the law of new matter and as such is inappropriately preventing Applicant from properly claiming his invention.

Any negative limitation or exclusionary proviso must have basis in the original disclosure. Notably, if alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) ("[the] specification, having described the whole, necessarily described the part remaining."). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984). This is the case in the present application. Applicant did in fact recite acrylic as a possible embodiment of fiber useable in the present application composite yarns. Applicant has now excluded that type of fiber using a negative limitation, in order to define around the prior art. This is specifically permitted as indicated

by the above noted cases. Applicant is permitted to limit the claims to less than the whole originally disclosed, *particularly where, as in this case, the element being excluded was specifically recited as an alternative in the specification.*

Accordingly, since the Examiner has misapplied the law regarding new matter, and the current negative limitation is specifically permitted by the above noted case law, the rejection under 35 U.S.C. 112, first paragraph must be withdrawn.

The claims stand rejected under 35 U.S.C. 103 over Chakravarti. Chakravarti discloses a cut resistant antimicrobial yarn and apparel made therefrom. In particular, the antimicrobial character of Chakravarti's yarns are provided by the required presence of antimicrobially treated acrylic fibers, forming the outer layer of the references antimicrobial yarn. (see Abstract and specification at column 1, lines 31-35). Chakravarti requires that the yarn contain acrylic fiber in its broadest aspects (see column 1, lines 31-32). It is the acrylic yarn that provides the antimicrobial properties of Chakravarti's yarn due to its treatment with an antimicrobial chemical.

However, the present invention composite cut-resistant yarn, as now claimed, cannot contain acrylic. Additionally, Applicant notes that while antimicrobial yarns are included as a preferred embodiment of the present invention, antimicrobial yarn is not required in the present invention.

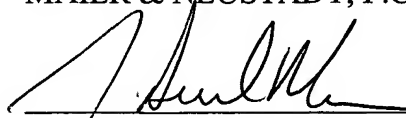
Further, there is absolutely nothing within Chakravarti to suggest using anything other than acrylic fiber to provide their yarns with antimicrobial properties. The Examiner has stated that it would be "obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate different antimicrobial treated fibers in the yarn of Chakravarti, so as to enable its use in different environments." However, the Examiner cannot build a *prima facie* case by suggesting that the reference be altered directly counter to its explicit teachings, as this would destroy the inventive aspects of Chakravarti's disclosure. Further, the

Examiner has provided absolutely nothing of record to suggest such a modification. Without some clear suggestion in the art to so drastically modify Chakravarti, the Examiner's position is unsustainable and should be withdrawn. Even if there were a reference to suggest such an alternative antimicrobial yarn, the Examiner cannot combine the teachings of one reference to destroy the explicit teachings of another reference in order to make out a *prima facie* case of obviousness. Accordingly, Chakravarti cannot render the present invention obvious by itself, and given the current claims which forbid the presence of acrylic fiber (a required element of Chakravarti), there is no reference that the Examiner can combine with Chakravarti to render the present invention obvious. As such, the rejection should be withdrawn.

Applicant submits that the application is now in condition for allowance and early notification of such action is earnestly solicited.

Respectfully submitted,

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